

Appl. No. : 09/630,931
Filed : August 2, 2000

Group VI comprising claims 37-50

Applicant has provisionally elected the claims of Group II for further examination; however, Applicant respectfully traverses the separate grouping of the claims of Group II (claims 7-20) and Group VI (claims 37-50). Although these claim Groups are patentably distinct, Applicants maintain that they can be examined together without serious burden on the Examiner. M.P.E.P. §803 provides that "if the search and examination of an application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (emphasis added). For the following reasons, Applicant believes that the foregoing claim groups can be examined together without serious burden because they each flow from the single observation that the cytoplasmic form of chitobiase can be utilized to monitor the transcriptional activity of promoters and they recite many of the same steps in common.

Even though the result of the process recited in the claims of Group II is different from the result of the process recited in the claims of Group VI, the claims of Groups II and VI can be examined together without serious burden. The claims of Group II are drawn to a method for identifying a regulatory element that is capable of regulating transcription within a test nucleic acid sequence. Identification of such a regulatory element is achieved by providing a nucleic acid construct which comprises a test sequence that is linked to a nucleic acid that encodes a cytoplasmic form of chitobiase. The nucleic acid construct is then introduced into a host cell and the resulting chitobiase activity is determined. The claims of Group VI are drawn to a method of monitoring a promoter to determine its activity. In such method, a nucleic acid construct comprising a nucleic acid encoding the cytoplasmic form of chitobiase operably linked to a promoter is provided. As with the Group II claims, the nucleic acid construct is then introduced into a host cell and the resulting chitobiase activity is determined. A search for methods in which a cytoplasmic form of chitobiase, is used as a reporter of transcriptional activity would enable the examination of the claims of both Group II and Group VI without imposing a serious burden on the Examiner. Regardless of whether only the claims of Group II or only the Claims of Group VI are elected, the scope of the search would not change. Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement as related to the claims of Group II and Group VI.

Appl. No. : 09/630,931
Filed : August 2, 2000

The Examiner also requires an election of species for Claim 10 of Group II. Applicant notes that an identical species election is required for Claim 40 of Group IV. Applicant provisionally elects *Vibrio harveyi* as the species for initial examination. Accordingly, upon allowability of the claims with respect to embodiments in which the species *Vibrio harveyi*, Applicant is entitled to seek consideration of the nonelected species as provided in 37 C.F.R. § 1.141.

CONCLUSION

Should the Examiner have any questions regarding the present response to the restriction requirement, he is invited to contact the undersigned at the telephone number provided below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 2, 2003

By:



Daniel Hart

Registration No. 40,637

Attorney of Record

Customer No. 20,995

(619) 235-8550